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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,847	04/21/2004	Mary Teresa Murphy	2550.0001	5357

7590

06/29/2005

Kevin J. McNeely
5301 Wilely Road
Bethesda, MD 20816

EXAMINER

ROYAL, PAUL

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/828,847	MURPHY, MARY TERESA	
	Examiner	Art Unit	
	Paul Royal	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a media disk label system and label, classified in class 40, subclass 641.
 - II. Claims 17-22, drawn to labeling software, classified in class 358, subclass 1.18.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the media disk labels of invention I can be marked by hand. The subcombination has separate utility such as labels for identifying stored, non-media goods.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney Kevin McNeeley on 06/21/05 a provisional election was made without traverse to prosecute the invention of claims 1-, claim 16. Affirmation of this election must be made by applicant in replying to this Office

Art Unit: 3611

action. Claims 17-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "binder" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 12 recites the limitation "the sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. As best understood, applicant is referring to the sheet introduced in claim 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, and 5-8, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minter (US 5,295,577) in view of LeMaitre (US 5,715,970).

Minter teaches a storage system for compact discs that includes a tray (110" which presents the organizer) and disk holders (210" where the holders present pockets) moveably attached to a binder (170", 160" - where the guide members and pins present a binder) in a stacked arrangement; and

an index (326") referencing a location of the media disks stored in the organizer, the index attached to the organizer.

Minter does not clearly teach the storage system/media disk organizer including insert cards insertable in the pockets.

Art Unit: 3611

LaMaitre teaches a CD (compact disk) storage case having a pocket (12- where the housing portion presents a pocket) and a square tray (30, where the tray presents an insert card inserted in the pocket), the label including a first insert portion (30) and an identifier tab (32) to enable easy identification and selection of the CD by a user.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the storage system/media disk organizer of Minter to include multiple CD storage cases each having a pocket and a label insert/tray, the label including a first insert portion and an identifier tab, as taught by LaMaitre, to enable easy identification and selection of the CD by a user.

Note, LaMaitre teaches the identifier tab can include indicia which is understood to include a symbol printed on a printable surface, see column 1, lines 35-38.

Note, the tab and the insertion card of LaMaitre are generally rectangular/square in shape.

For claim 7, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the insertion card into a circular shape to coincide with the circular shape of the CD.

For claims 13-15, the method of organizing media disks is the inherent method of using the apparatus disclosed in the above claims.

8. Claims 4, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minter in view of LeMaitre, as applied to claim 1, in further view of Gelardi et al. (4,875,743).

Art Unit: 3611

Minter in view of LeMaitre, as applied to claim 1, teaches a media disk label system having the claimed limitations except specific positioning of the tabs and a semi-circular tab.

Gelardi et al. teaches a recording media storage apparatus including semi-circular index tabs (50) arranged to extend beyond a left, middle and right edge of a C-shaped holder/lever member (22 where the holder/lever member form a pocket for holding the CD) in a staggered arrangement.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the storage system/media disk organizer of Minter and Lamaitre, as applied to claim 1 to include semi-circular index tabs arranged, as taught by Gelardi et al., to extend beyond a left, middle and right edge of a pocket in a staggered arrangement such that a first label has a first insert portion and a first tab extending from a left side of the first insert portion to a position beyond an edge of the first pocket when the first insert portion is positioned in the first pocket; a second label has a second insert portion and a second tab extending from a middle-portion of the second insert portion to a position beyond an edge of the second pocket when the second insert portion is positioned in the second pocket; and a third label has a third insert portion and a third tab extending from a right side of the third insert portion to a position beyond an edge of the third pocket when the third insert portion is positioned in the third pocket.

Art Unit: 3611

9. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minter, in view of LeMaitre, and Gelardi et al. as applied to claim 9, in further view of Tracy (US 6,155, Q26).

Minter, in view of LeMaitre, and Gelardi et al. as applied to claim 9, teaches a media disk label system having the claimed limitation except a sheet having perforations configured to be separated into first, second and third labels, the sheet including a printable surface.

Tracy teaches perforated printable stock sheets (1) for labeling a CD-ROM jewel case to provide a labeling sheet with separable edges that do not need to be cut for each label.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the storage system/media disk organizer of Minter, in view of LeMaitre, and Gelardi et al. as applied to claim 9, to include perforated printable stock sheets for labeling a CD-ROM, as taught by Tracy, to provide a labeling sheet with separable edges that do not need to be cut for each label.

Note the label insertion cards as well as the jewel case identify the CD-ROM and are of similar structure and therefore the same process for preparing the jewel case is applicable to the insertion card.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minter in view of LeMaitre as applied to claim 13, in further view of Lidetke (US 6,271,932).

Minter in view of LeMaitre as applied to claim 13, teaches a media disk label system having the claimed limitation except providing a computer program to instruct a computer system having a printer to print an identifier on the label.

Lidetke teaches a media disk label system including having a computer program (26) to instruct a computer system having a printer () to print an identifier on a label (2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the media disk label system of Minter in view of LeMaitre as applied to claim 13, to include having a computer program to instruct a computer system having a printer to print an identifier on a label.

Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stewart et al. teaches a compact disk organizer. Bergh et al. teaches a three ring binder page for holding compact discs. Youngs teaches a compact disc storage container.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Royal whose telephone number is 571-272-6652. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

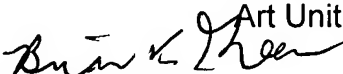
Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



P. Royal
6/23/2005

Paul Royal
Examiner
Art Unit 3611



BRIAN K. GREEN
PRIMARY EXAMINER